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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,418

09/05/2003

David J. Parins

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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

07/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/656,418	<b>Applicant(s)</b> PARINS, DAVID J.	
	<b>Examiner</b> JEFFREY G. HOEKSTRA	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 12-14, 21, 22, 30, 31, 38, 39 and 44-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-11, 15-20, 23-29, 32-37 and 40-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date : 12/08/03, 05/11/05, 05/02/07, 03/04/08, & 06/20/08.

## **DETAILED ACTION**

### ***Notice of Reply***

1. In response to the Reply filed on 06/20/2008, withdrawn claim(s) 3-5, 12-14, 21, 22, 30, 31, 38, 39, and 44-63 is/are acknowledged. The following is/are set forth:

### ***Election/Restrictions***

2. Applicant's election without traverse of Species AA, drawn to Figure 1, in the reply filed on 06/20/2008 is acknowledged.

3. Claims 3-5, 12-14, 21, 22, 30, 31, 38, 39, and 44-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 06/20/2008.

4. Applicant argues and the Examiner agrees at least independent claims 1, 10, and 19 appear generic to the identified species.

### ***Information Disclosure Statement***

5. The information disclosure statement(s) (IDS) submitted on 12/08/03, 05/11/05, 05/02/07, 03/04/08, and 06/20/08 is/are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement(s).

6. The Examiner notes a number of cited foreign patent documents and/or non-patent literature did not have copies present in the application. The Examiner respectfully requests Applicant submit copies of the non-considered references for the record and consideration on the merits.

***Drawings***

7. The drawings were received on 09/05/2003. These drawings are acceptable.

***Specification***

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Double Patenting***

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Applicant is advised that should claim 10, and those depending therefrom, be found allowable, claim 1, and those depending therefrom, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application

are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

11. Applicant is advised that should claim 10, and those depending therefrom, be found allowable, claim 1, and those depending therefrom, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 6, 7, 8, 10, 15, 16, 17, 19, 23, 24, 25, 28, 32, 33, 34, 36, 40, 41, 42, rejected under 35 U.S.C. 102(b) as being anticipated by Urick et al. (US 5,947,783, hereinafter Urick).

14. For claims 1, 10, 19, 28, and 36, Urick discloses and shows a an intracorporeal device comprising a guidewire (60) (as best seen in Figure 8) (the Examiner notes however the reference numerals of Figure 8 do not appear to match the detailed description, the citations below will reference the detailed description) (column 4 lines 51-63 and column 6 lines 44-56), comprising:

Art Unit: 3736

- an elongate shaft (26) (column 4 lines 51-63 and column 6 lines 44-56) inherently having a proximal end (the left end as best seen in Figure 8) and inherently having an opposing distal end (the right end as best seen in Figure 8);
- a helically wound coil (48) (column 4 lines 51-63 and column 6 lines 44-56) inherently having a plurality of windings (the windings of helically wound coil 48 as best seen in Figure 8), inherently having an outer perimeter (the outer perimeter of helically wound coil 48 as best seen in Figure 8), and inherently forming a coil length (the coil length of helically wound coil 48 as best seen in Figure 8), said coil length disposed about a portion of the distal end (as best seen in Figure 8); and
- a plurality of joining elements (62, 64, 66, 68, and 70) (column 4 lines 51-63 and column 6 lines 44-56) disposed on only a portion of the outer perimeter (as best seen in Figure 8) and along the coil length (as best seen in Figure 8), wherein each joining element couples two coil windings (as best seen in Figure 8), and wherein each joining element is a discrete element (as best seen in Figure 8).

15. For claims 6, 15, 23, 32, and 40, Urick discloses and shows the guidewire, wherein the joining elements form a uniform pattern of joining elements along the coil length (as best seen in Figure 8).

16. For claims 7, 16, 24, 33, and 41, Urick discloses and shows the guidewire, wherein each joining element couples 3 to 10 coil windings (as best seen in Figure 8).

17. For claims 8, 17, 25, 34, and 42, Urick discloses and shows the guidewire, wherein each joining element is a discrete element aligned orthogonal to the windings in a radial direction (as best seen in Figure 8).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 2, 9, 11, 18, 20, 26, 27, 29, 35, 37, 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Urick.

20. For claims 2, 9, 11, 18, 20, 26, 27, 29, 35, 37, 43, Urick discloses and shows the guidewire as set forth and cited above, including the guidewire having at least 5 joining elements having a width of 0.002" or 0.05mm, except for expressly disclosing (a) the joining elements including at least 10 elements disposed along the coil length, (b) wherein each joining element has a width in the range of 0.1 to 0.5 mm and a length in the range of 0.1 to 1.5 mm, and (c) each joining element is disposed on less than 1/10 of the outer perimeter of each winding.

21. As evidenced by Applicant "the number and size of the joining elements can be varied to obtain the desired characteristics". The Specification at at least pages 7-8 reads as follows:

22. *"A plurality of joining elements 120 can be disposed along the coil length L. The joining elements couple a plurality of coil windings 105 together. Each joining element 105 may join from 2, 3, 4, 5, 6, 7, 8, 9, or 10 or more coil windings 105 together. There may be 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 25, 30, 35, 40 or more joining elements 120 disposed in a uniform or non-uniform pattern along the coil*



*length. In at least some embodiments, the joining elements 120 may only function to join coil windings 105 together. For example, in at least some embodiments, the coil joining element or elements 120 join a plurality of coil windings 105 together, but do not act to join any other structure within the device 100. In such embodiments, the coil joining element or elements 120 act only to join coil windings 105 together, and do not join any other structure to the coil. For example, in some such embodiments, the joining elements 120 do not join the coil 110 to the shaft or core 130.*

23. *“The joining elements 120, by interconnecting a series of coil windings, can provide enhanced torque transmission along the coil length L and/or enhanced push-ability while still providing flexibility that a coil 110 offers. The degree of enhanced torque transmission and/or push-ability is dependent at least in part on the number of joining elements along the length of the coil, and the size of each joining element (i.e. the number of coil windings joined by each joining element). Those of skill in the art, and others will recognize that as a general proposition, that greater enhanced torque transmission and/or push-ability can be achieved by using a greater the number of joining elements along a coil length, and/or by increasing the number of coil windings 105 joined by each joining element 120. The number and size of the joining elements 120 can be varied to obtain the desired characteristics.*

24. *“In some embodiments, the joining elements 120 may have a length in the range of about 0.1 to about 1.5 mm and a width in the range of about 0.1 to about 0.5 mm. The joining elements 120 can be discrete elements aligned orthogonal to the coil windings 105 as illustrated in Fig. 1. The joining elements 120 may be formed of a*

*material the same as or different from the coil 110. The coil windings 105 define an outer perimeter 150. The joining elements 120 can be disposed about the outer perimeter 150 such that only a portion of the outer perimeter 150 is covered by joining elements 120. In some embodiments, each joining element 120 may be disposed on less than 1/10 of the total outer perimeter 150 of each winding 105."*

25. Urick discloses the claimed invention but does not disclose expressly the configurations (a), (b), and (c) of the joining elements. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the guidewire as taught by Urick with the configurations (a), (b), and (c) of the joining elements, because Applicant has not disclosed that configurations (a), (b), and (c) of the joining elements provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with configuration of the joining elements as taught by Urick, because it provides for configuring the flexibility and torqueability of a guidewire and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Urick. Therefore, it would have been an obvious matter of design choice to modify Urick to obtain the invention as specified in the claim(s).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

Art Unit: 3736

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.H./

Jeff Hoekstra  
Examiner, Art Unit 3736

/Max Hindenburg/

Supervisory Patent Examiner, Art Unit 3736